

REMARKS

Claims 1-11 are pending in this application. Claims 1-11 stand rejected. By this Amendment, claims 1-3, 6, and 9 have been amended. The amendments made to the claims do not alter the scope of these claims, nor have these amendments been made to define over the prior art. Rather, the amendments to the claims have been made to improve the form thereof. In light of the amendments and remarks set forth below, Applicant respectfully submits that each of the pending claims is in immediate condition for allowance.

Paragraphs 1-3 of the Office Action reject claims 1, 2, 6, and 9 under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement. The Examiner objects to the statement “writes said frame to a memory location shifted from a top of a frame buffer”. The Office Action states that this limitation does not enable one skilled in the art to understand the invention because it causes errors and inefficiency to the device’s invention. Two examples are then presented one in which the first frame is written into the memory location shifted from the top frame buffer which causes a waste in memory according to the Office Action and a second example where a second frame coming into the device after the first frame is written to the memory location shifted from the top of the frame buffer which causes an overlap with the already stored first frame in the buffer. Applicant respectfully disagrees with this interpretation.

Applicant assumes that the Examiner is alleging that the claim is inoperative. See, M.P.E.P. § 2164.08(b). The Examiner has failed to show any

embodiments which would be inoperative or operative with expenditure of no more effort than is normally required in the art.

With respect to the Examiner's first example, the first frame is written into the memory location shifted from the top of the frame buffer which, the Examiner alleges results in a waste of memory. Applicant has amended the claims to clearly recite that the frame is written from a top of the next available memory location in a frame buffer. Thus, there is not a waste of memory.

Regarding the second example, the Examiner asserts that data will constantly be overwriting existing data. As the claims are currently written, no data will be overwritten. The data is written at a location shifted from atop of the next available memory location in a frame buffer. Thus, the next available location is written to not a position that contains data. Thus, Applicant respectfully requests withdrawal of this rejection.

Paragraph 3 of the Office Action rejects claim 1 as vague and indefinite since the claim recites on a single means and thus encompasses all possible means for performing a desired function. Applicant respectfully requests withdrawal of this rejection. Applicant's claim recites:

1. A frame-relay frame processing device for reassembling a frame-relay frame into an Asynchronous Transfer Mode (ATM) cell, wherein said device receives a frame-relay frame and writes said frame to a memory location shifted from a top of the next available memory location in a frame buffer.

Applicant points out that this is not a means claim. Applicant has not taken advantage of 35 U.S.C. § 112, sixth paragraph, and drafted claim 1 using means language. Thus, this rejection is incorrect and Applicant respectfully requests withdrawal of this rejection.

Paragraphs 4 and 5 reject claims 1-11 under 35 U.S.C. § 103(a) as being unpatentable over Stoner in view of Chao. Applicant respectfully requests reconsideration and withdrawal of this rejection.

To establish a *prima facie* case of obviousness, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify a reference or combine references to arrive at the claimed subject matter. The prior art references must also teach or suggest all the limitations of the claim in question. See, M.P.E.P. § 706.02(j). A reference can only be used for what it clearly discloses or suggests. See, In re Hummer, 113 U.S.P.Q. 66 (C.C.P.A. 1957); In re Stencel, 4 U.S.P.Q.2d 1071, 1073 (Fed. Cir. 1987). Here, the references, whether taken individually or in combination, do not disclose or suggest the invention claimed by the Applicant.

The Office Action admits that Stoner does not disclose that the frame is written from an address shifted from the top of the frame buffer which is well known in the art for data frame organization in the buffer.

In accordance with Patent and Trademark Office practice, an Examiner can only rely upon official notice where the facts asserted are "capable of instant and unquestionable demonstration as being well-known." M.P.E.P. § 2144.03A. For

this reason, "in limited circumstances, it is appropriate for an Examiner to take official notice of facts not in the record or to rely on 'a common knowledge' in making a rejection; however, such rejections should be judiciously applied."

M.P.E.P. § 2144.03.

As will be shown below, the Office Action used official notice improperly. Specifically, official notice was taken of facts of a type specifically held not to be the subject of official notice. In addition, official notice also was taken as to legal conclusions related to patentability, when official notice is only to be applied to facts.

The Office Action states: "Official Notice is taken that all of the elements, categories, comparisons, 'cuts' of data and statistical analysis recited by the claims . . . are routine methods of business analysis" However, the issue of whether the elements, categories, etc., are *routine* is exactly the type of thing that official notice may *not* be relied upon for. See, M.P.E.P. § 2144.3A ("[W]e reject the notion that judicial or administrative notice may be taken of the state of the art. The facts constituting the state of the art are normally subject to the possibility of rational disagreement among reasonable men and *are not amenable to the taking of such notice.*" Citing, In re Eynde, 480 F2d 1364,1370 (C.C.P.A. 1973). (Emphasis supplied).

In view of the fact that the M.P.E.P. specifically states that official notice may not be used with regard to the state of the art, the Examiner is requested in the next Office Action to provide evidence that "Stoner does not disclose that the frame is written from an address shifted from the top of a frame buffer, which is well

known in the art for data frame organization in the buffer.” Of course, such evidence should have been provided in the first place to support a finding of obviousness.

The Office Action attempts to use Chao to disclose Applicant’s explicitly recited limitation. However, Chao fails to disclose this limitation. In Chao, ATM cells are written to a FIFO buffer. The cells are not written to a memory location shifted from a top of a frame buffer as explicitly recited in Applicant’s claim. Chao discloses at column 6, lines 50-65, the use of a FIFO memory that is shared among all priorities. In Chao, the cells are stored in a single physical cell pool and then retrieved in sequence according to their priority levels. FIFO 34, in Figure 8, stores the addresses of the empty entries in the cell pool so that when a cell arrives it can be sent to a proper FIFO based on its priority level and an idle address. This is not Applicant’s explicitly recited limitation of writing a frame relay to a memory location shifted from a top of a frame buffer. It should be noted that an AAL5 frame header requires greater memory than the frame relay frame. As such, Applicant’s explicitly claimed invention can be used when AAL5 frame headers require greater memory than the frame.

Claim 2 depends from, and contain all the limitations of claim 1. This dependent claim also recites additional limitations which, in combination with the limitations of claim 1, is neither disclosed nor suggested by Chao and is also believed to be directed towards the patentable subject matter. Thus, claim 2 should also be allowed.

Claims 4 and 5 depend from, and contain all the limitations of claim 3. These dependent claims also recite additional limitations which, in combination with the limitations of claim 3, are neither disclosed nor suggested by Chao and are also believed to be directed towards the patentable subject matter. Thus, claims 4 and 5 should also be allowed.

Claims 7 and 8 depend from, and contain all the limitations of claim 6. These dependent claims also recite additional limitations which, in combination with the limitations of claim 6, are neither disclosed nor suggested by Chao and are also believed to be directed towards the patentable subject matter. Thus, claims 7 and 8 should also be allowed.

Claims 10 and 11 depend from, and contain all the limitations of claim 9. These dependent claims also recite additional limitations which, in combination with the limitations of claim 9, are neither disclosed nor suggested by Chao and are also believed to be directed towards the patentable subject matter. Thus, claims 10 and 11 should also be allowed.

Applicant has responded to all of the rejections and objections recited in the Office Action. Reconsideration and a Notice of Allowance for all of the pending claims are therefore respectfully requested.

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue.

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If the Examiner believes an interview would be of assistance, the Examiner is welcome to contact the undersigned at the number listed below.

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Respectfully submitted,

By 

Ian R. Blum

/Registration No.: 42,336

DICKSTEIN SHAPIRO MORIN &
OSHINSKY LLP

1177 Avenue of the Americas - 41st Floor

New York, New York 10036-2714

(212) 835-1400

Attorney for Applicant

IRB/mgs